

Serial No. 09/083,422
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PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Scott Clare
Neil G. Long

Serial No.: 09/083,422

Filed: May 22, 1998

For: A STORAGE SYSTEM FOR VEHICLES

Group Art Unit: 3612

Examiner: Dennis H. Pedder

Atty. Dkt. No.: INN643/4-013

Confirmation No. 3984

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Sir:

The present appeal brief (filed in triplicate) is filed in support of Appellants' Notice of Appeal of the Final Official Action issued June 27, 2005.

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CLARE AND LONG APPEAL BRIEF

I. REAL PARTY IN INTEREST

The real parties in interest are Scott Clare, Neil Long and the exclusive licensee of this patent application, Innovative Truck Storage, Inc. (a small entity, which has granted a sublicense under this application to Royal Truck, Inc., another small entity, and to General Motors, a large entity).

II. RELATED APPEALS AND INTERFERENCES

An appeal is pending in a related application, Serial No. 10/330,686, filed on December 22, 2002. No other appeals or interferences are known to the Appellants which will affect, may be affected by, or will have a bearing on the Board's decision in the present case.

III. STATUS OF CLAIMS

This application was filed on May 22, 1998, with Claims 1-23. Claims 6, 8, 9, 13 and 15-23 were canceled and Claims 24-33 added in a preliminary amendment filed concurrently. Claims 34-42 were added by amendment and claim 29 was cancelled in a response to the Office Action of August 18, 1998. Claims 43-48 were added by amendment in a response to the Office Action of October 18, 1998. A Continued Prosecution Application (CPA) was filed on December 29, 2000 canceling Claims 2-5, 7, 10-12, 14, 24-28 and 30-48, and adding new Claims 49-97. Claims 75-84, 90 and 95 were canceled as drawn to a non-elected species and Claims 98-127 were added in a response to the Office Action of June 6, 2001. Claim 1 was canceled as drawn to a non-elected

invention and Claims 63, 102, 112 and 117 were canceled in a response to the Final Office Action of February 1, 2002. Claims 100, 103, 104, 107, 110, 115, and 125 were canceled in a response to the Office Action of July 12, 2002. Claims 114, 116 and 118-124 were cancelled on January 9, 2003. Finally, Claim 93 was cancelled on January 24, 2005.

Claims 49-62, 64-74, 85-89, 91, 92, 94, 96-99, 101, 105, 106, 108, 109, 111, 113, 126 and 127 are in the case. Claims 94, 96, 97, 126, and 127 are allowed. Claims 57, 74 and 87 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 49-56, 58-62, 64-73, 85-86, 88-89, 91, 92, 98, 99, 101, 105, 106, 108, 109, 111, and 113 stand rejected.

IV. STATUS OF AMENDMENTS

No amendments of the claims have been submitted after the Final Office Action. Appellants received an Advisory Action mailed on September 23, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The instant inventions involve enclosed light trucks such as family vans and sport utility vehicles that include a unique storage system. See, e.g., p.2, l.10. These vehicles typically have a cargo or seating area behind the front seat that includes a floor area and outer walls. The floor conventionally extends over the rear wheels and a raised area called the wheel wells rises above the level of the floor and inside the outer walls in the cargo area. The instant inventions include vehicles in which a storage area is adjacent to, but separate from the cargo area and extends into the cargo area no further than the wheel wells. See, e.g. p.1, l.25 – p.2, l.2. In certain embodiments, the storage areas may extend over the wheel well, see, e.g. p.13, l.15, forward of the wheel well or rearward of the wheel well. See, e.g., p.11, l.8. The storage areas are accessible from outside the vehicle and a hinged opening in the exterior of the vehicle provides access to the storage system. See, e.g., p.3, l.14-20.

Because it is often awkward to store or carry materials within the area over or in front of, or behind the wheel wells, the storage systems do not significantly decrease the useable storage volume within the vehicle cargo area, but rather add a useful storage compartment, analogous to a car trunk. The storage systems do not substantially alter the

appearance of the exterior of the vehicles, which maintain the aesthetically appealing contours of a conventional vehicle without the extra storage space. See, e.g., p.2, l.25 – p.3, l.3. Thus, in these embodiments, the side panels of the rear portion of the vehicle are aligned with the side panels of the driver's compartment as in a conventional vehicle without the storage system, or the separation width and cross-sectional contour of the side panels of the rear of the vehicle containing the storage system are substantially the same as the separation width and cross-sectional contour of the forward compartment where it adjoins the side panels of the rear area. See, e.g., p.14, ll.15-18.

VI. GROUNDS OF REJECTION TO BE REVIEWED UPON APPEAL

1. Are Claims 49-55, 58, 60, 98-99, 101, 106, and 108-109 properly rejected under 35 U.S.C. § 103(a) over Sparling (U.S. Patent No. 4,315,653) in view of Hawkins (U.S. Patent No. 2,159,022)?

2. Are Claims 61-62, 64-68, 70-72, 111, and 113 properly rejected under 35 U.S.C. § 103(a) over Stahl (U.S. Patent No. 2,192,207) in view of Hawkins?

3. Are Claims 85-86, 89, and 91-92 properly rejected under 35 U.S.C. § 103(a) over Stahl or Sparling in view of Hawkins and Hamel (U.S. Patent No. Des. 230,351)?

4. Are Claims 56 and 73 properly rejected under 35 U.S.C. § 103(a) over Sparling or Stahl in view of Hawkins and further in view of Hamel?

5. Are Claims 59 and 88 properly rejected under 35 U.S.C. § 103(a) over Sparling or Stahl in view of Hawkins optionally in view of Hamel and further in view of Gallagher et al. (U.S. Patent No. 5,709,309)?

6. Are Claims 69 and 73 properly rejected under 35 U.S.C. § 103(a) over Stahl in view of Hawkins and further in view of Hamel?

7. Is Claim 105 properly rejected under 35 U.S.C. § 103(a) over Sparling in view of Hawkins and further in view of Powers (U.S. Patent No. Des. 143,990)?

VII. ARGUMENT

A. The Rejection of Claims 49-55, 58, 60, 98-99, 101, 106, and 108-109 Under 35 U.S.C. § 103(a) Over Sparling In View of Hawkins Should Be Overturned.

The Final Office action rejects the above mentioned claims as obvious under 35 U.S.C. § 103(a) over Sparling in view of Hawkins. The Examiner has stated that “it would have been obvious to one of ordinary skill to provide in Sparling a storage

compartment as taught by Hawkins in order to store tools, spare parts, etc. away from the passenger compartment” claiming that the motivation to modify the vehicle of Sparling “is knowledge generally available to one of ordinary skill in the art.”

The Examiner has failed to establish the first criterion for a *prima facie* case of obviousness. The Examiner has not referred to any suggestion to combine the references within the references themselves and has also failed to provide an objective reason to combine the references derived from the knowledge of one of ordinary skill in the art. “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made”... is not sufficient to establish a *prima facie* case of obviousness.” MPEP § 2143.01 (citing *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). The Examiner’s unsupported sweeping statement that the motivation to modify the vehicle of Sparling and combine the references “is knowledge generally available to one of skill in the art” is simply insufficient to establish a suggestion or motivation to combine the reference teachings.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). Neither Sparling or Hawkins describes or suggests a storage system that addresses the problem of providing a storage system that is accessible from the outside of a vehicle by utilizing space that is typically inaccessible or poorly accessible while maintaining the space in a passenger compartment.

The vehicle in Hawkins is a utility truck with a driver’s compartment, a separate storage system, and no rear passenger compartment. The vehicle in Hawkins cannot be said to suggest the present invention because it is a commercial vehicle with a large bulky storage system. The Hawkins reference is clearly not directed to addressing the problem of providing a storage system for vehicles with a driver compartment and passenger compartment in a single enclosure which utilizes otherwise inaccessible or poorly accessible space. The vehicle in Sparling is a pick-up truck with a camper top, and the Sparling reference does not seek to address any storage system. The examiner has simply offered no explanation of what would motivate a person of ordinary skill in the art to

modify the pick-up truck of Sparling with the storage system of Hawkins, and has offered no explanation, based on the prior art or on any general knowledge of how such a storage system would work.

As the Examiner has failed to show any suggestion or motivation to combine the references, either in the references themselves or in the knowledge of one of ordinary skill in the art, he has failed to establish a *prima facie* case of obviousness, and the rejection is improper. Appellants therefore respectfully request that the Board overturn the Examiner's rejection.

B. The Rejection of Claims 61-62, 64-68, 70-72, 111, and 113 Under 35 U.S.C. § 103(a) over Stahl (U.S. Patent No. 2,192,207) In View of Hawkins Should Be Overturned

The Final Action also rejects claims 61-62, 64-68, 70-72, 111 and 113 over Stahl in view of Hawkins.

Appellants traverse this rejection in that Stahl is not properly combinable with Hawkins as once again the Examiner has completely failed to make a *prima facie* case of obviousness and makes no attempt to even find motivation for the hind sight reconstruction of the claimed invention. Neither would the combination as cited in the Action reach the claimed invention.

The vehicle of Stahl is clearly a utility truck designed to have a large rear storage area. The storage area in Stahl is separated from and behind the driver and passenger compartments. See, e.g. Stahl, Figs. 1, 4, 7 & 8. The Examiner has pointed out the partition, see, e.g. Stahl, Fig. 1, 8 ("Partition 8"), which separates the rear compartment seating area from the storage area. The specification of Stahl identifies Partition 8 as dividing the body of the vehicle into a crew carrying compartment and a storage compartment. See col. 2, ll. 48-50. Thus, the storage compartment of Stahl occupies the entire rear portion of the vehicle.

The Examiner suggests that the vehicle in Stahl can be provided with the storage area of Hawkins which is argued to be less than the width of the wheel. However, such a combination does not satisfy the claim limitation of a storage area which extends into the enclosure no further than the wheel well extends into the enclosure. The incorporation of

the storage system of Hawkins in the vehicle of Stahl does not teach limiting the storage to a width not greater than the wheel well because the storage compartment of Stahl is defined by the location of Partition 8 as per the specification of Stahl. Thus, the combination of Stahl and Hawkins does not satisfy the claim limitation that the storage compartment extend into the enclosure no further than the wheel well.

In order to limit the storage compartment of Stahl so that it does not extend into the enclosure further than the wheel wells extend into the enclosure, it would be necessary to remove Partition 8, thereby greatly enlarging the passenger compartment and eliminating the large scale storage capacity of the vehicle in Stahl. This type of change would render the vehicle in Stahl unfit for its intended purpose and dramatically alter the character of the vehicle.

C. The Rejection of Claims 85-86, 89, and 91-92 Under 35 U.S.C. § 103(a) Over Sparling or Stahl In View of Hawkins and Hamel Should Be Overturned.

The Examiner rejected Claims 85-86, 89, and 91-92 as obvious over Sparling or Stahl in view of Hawkins and Hamel. As discussed above, the Examiner has failed to show a suggestion or motivation to combine Sparling or Stahl with Hawkins. The addition of Hamel does not cure the previously discussed failure to establish a motivation or suggestion to combine the references.

The Examiner referred to Hamel in rejecting Claims 85-86, 89, and 91-92 stating that it would be "obvious to hinge the side panel section at top and support with strut as taught by Hamel as a shelter from rain, for example." The Examiner offered no other discussion of Hamel in this rejection. Clearly, the Examiner's statement does not provide a suggestion or motivation to combine Hamel with any of the other identified references, let alone cure the lack of a suggestion to combine Sparling or Stahl with Hawkins. In making this rejection, the Examiner again made no mention of any suggestion or motivation to combine the references. Consequently, the Examiner has still not established a *prima facie* case of obviousness as he has failed to satisfy all three criteria set forth in MPEP § 2142.

Furthermore, the Examiner's attempt to discover some hindsight motivation is not even relevant to the rejected claims, and the suggested modification does not reach the

claimed inventions. The Specification in no way teaches that the hinged panel is to be used as a shelter from the rain. This is not motivation to combine the references and this rejection has no merit. Appellants thus assert that the rejection is improper and respectfully request that the Board overturn the Examiner's rejection.

D. The Rejection of Claims 56 and 73 Under 35 U.S.C. § 103(a) Over Sparling or Stahl in View of Hawkins, And Further In View of Hamel Should Be Overturned.

The Final Action rejects claims 56 and 73 as obvious based on the argument that it would be obvious to provide any of the references a top hinge side panel section with a strut in order to shelter from rain.

Appellants have previously addressed this rejection, and find the Action's attempt to provide motivation to be completely irrelevant to the claims. Appellants have not found a mention of providing shelter from rain in the Specification or claims, nor in any of the prior art references. Appellants respectfully request that this rejection be overturned.

E. The Rejection of Claims 59 and 88 Under 35 U.S.C. § 103(a) Over Sparling or Stahl in View of Hawkins, Optionally In View of Hamel, and Further In View of Gallagher et al. Should Be Overturned.

The Examiner rejected Claims 59 and 88 as obvious in light of the above described combination of references and stated that "[i]t would have been obvious to one of ordinary skill to provide in each set of references above a drain/air relief valve as taught by Gallagher et al. in order to remove moisture from the compartment," referring to his arguments discussed above. Since Appellants have shown that the Sparling, Stahl, Hawkins and Hamel references are insufficient to establish a *prima facie* case of obviousness due at least to a failure to show a motivation or suggestion to combine the references, and given that the Examiner has offered no such suggestion or motivation in this rejection, a *prima facie* case of obviousness has not been established.

The addition of the valve described in Gallagher does nothing to improve the rejections over the other cited references and this rejection remains improper. Appellants thus respectfully assert that the rejection is improper and should be overturned.

F. The Rejection of Claims 69 and 73 Under 35 U.S.C. § 103(a) Over Stahl In View of Hawkins and Further in View of Hamel Should Be Overturned.

This rejection re-iterates the Action's attempt at finding some motivation for hindsight reconstruction of the claimed inventions, again making an unsupported statement that it would be obvious to provide an upper hinged section with a strut support in order to access without bending and protect from rain.

Appellants feel this ground of rejection has been fully addressed and that the rejection has no merit. Appellants respectfully request the Board to overturn this rejection.

G. The Rejection of Claim 105 Under 35 U.S.C. § 103(a) Over Sparling In View of Hawkins and Further In View of Powers Should Be Overturned.

The Examiner rejected Claim 105 as obvious over the combination of Sparling, Hawkins, and Powers. The Examiner argued that “[i]t would have been obvious to one of ordinary skill to provide in the references above a width of the wheel well approximately that of the storage area as taught by Powers in order to increase the storage volume or larger items.”

This rejection completely misunderstands Claim 105. Claim 105 is not drawn to a vehicle with a wheel well configured to have a width equal to that of the storage area, but rather Claim 105 provides a storage system where the storage area has a width approximately equal to the width of the wheel well. The width of the wheel well in vehicles is driven by different considerations than the problems solved by the disclosure in Claim 105. This Claim applies to a storage system which utilizes space which is generally poorly accessible or inaccessible due to the presence of the wheel well. As Claim 105 is not directed to a vehicle with modified wheel wells the rejection is improper and should be overturned.

Additionally, as previously shown above, the Examiner has shown no suggestion or motivation to combine Sparling and Hawkins in the references themselves, or in the knowledge of one of skill in the art. The Examiner has also failed to show such a suggestion or motivation in the rejection of Claim 105 over the combination of Sparling, Hawkins, and Powers. Therefore, even if the rejection had been properly addressed to

the disclosure of Claim 105, the rejection would still be improper for failure to establish a *prima facie* case of obviousness. Therefore, Appellants respectfully request that the Board overturn the rejection.

H. All Rejections Under 35 U.S.C. § 103(a) Over Sparling In View of Hawkins and/or Hamel Should Be Overturned Because the References Are Not Properly Combinable.

The Examiner has failed to make out a *prima facie* case of obviousness because the primary reference, Sparling, and secondary references, Hawkins and Hamel, are not properly combinable, and thus, the Examiner has not shown a suggestion or motivation to combine. "If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01.

The vehicle of Sparling may not properly be combined with the storage systems of Hawkins or Hamel, because such a combination would destroy the additional passenger seating function of Sparling as clearly expressed throughout the specification of Sparling. Several of the embodiments of Sparling have additional passenger seating located in and above the rear wheel wells. See Col.1, l.63 – col.2, l.2; col.3, ll.15-20; col.5., ll. 7-10; col.5, ll.22-26; col.5, ll.27-33. In each of these embodiments, the additional passenger seating is mounted by either cutting out a portion of the rear wheel wells to allow space for mounting the seats, or the seats are specially designed to mount onto the top surface of the wheel well. In both mounting configurations, the seats will necessarily occupy space above the wheel well.

It cannot be argued that the additional passenger seating provided in Sparling is a non-essential part of the reference. Sparling provides for modified rear wheel mounts and fender flares so that the rear wheels can be moved outwards away from the seats to accommodate the new seating configuration. These additional modifications, which serve no independent purpose and are unrelated to other aspects of the reference, support the fact that the additional passenger seating is a critical component of the invention of Sparling. The placement of seating over the wheel wells in Sparling actually teaches away from Appellants' claims, because in Appellants' claims, this space is used for

storage and not used for additional seating capacity.

If the storage systems of Hawkins or Hamel were combined with the vehicle of Sparling, as the Examiner suggests, and placed over the wheel wells, as claimed in Appellants' application, the storage system would interfere with the additional seating of Sparling rendering it unfit for seating. Thus, the combination of these references would render the vehicle of Sparling unfit for providing additional seating capacity.

Since the Examiner's rejections using these references renders the Sparling reference unfit for an intended purpose, there is no suggestion or motivation to combine the references. MPEP § 2143.01. Without a suggestion or motivation to combine the references, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection is improper. See MPEP § 2142. Appellants respectfully request that the Board overturn all rejections which rely on the combination of Sparling with Hawkins or Hamel.

I. All Rejections Under 35 U.S.C. § 103(a) Over Stahl In View of Hawkins and/or Hamel Should Be Overturned.

The Examiner cited Stahl for a vehicle with contoured side panels and a forward and rear compartment within the same enclosure and cited Hawkins for storage which has "less width than the wheel well." The Examiner cited to Hamel for hinged side panels and a strut to support hinged side panels.

The Examiner rejected Claims 56, 59, 61-62, 64-73, 85-86, 88-89, 91-92, 111, and 113 under 35 U.S.C. § 103(a) using Stahl as the primary reference and Hawkins and/or Hamel as secondary references, optionally in combination with other tertiary references. As stated in Part A above, the Examiner bears the initial burden of factually satisfying all three criteria for a *prima facie* case of obviousness. The Examiner has failed to establish that the combination of Stahl, Hawkins, and/or Hamel and any other tertiary reference teach or suggest all elements of the claims, and therefore, the Examiner has not established a *prima facie* case of obviousness.

One of the advantageous characteristics of Appellant's disclosure is the novel use of the space around the rear wheel wells within the passenger compartment of the disclosed vehicles that is generally inaccessible or poorly accessible. Claims 56, 59, 61-

62, 64-73, 85-86, 88-89, 91-92, 111, and 113 all contain the claim limitation of a storage system which extends into the enclosure of the vehicle no further than the wheel wells extend into the enclosure. The purpose of limiting the storage area to extending no further than the wheel well extends into the enclosure is to limit the impact of the storage area on the passenger compartment while utilizing otherwise inaccessible or poorly accessible space.

The vehicle of Stahl is clearly a utility truck designed to have a large rear storage area. The storage area in Stahl is separated from and behind the driver and passenger compartments. See, e.g. Stahl, Figs 1, 4, 7 & 8. The Examiner has pointed out the partition, see, e.g. Stahl, Fig. 1, 8 ("Partition 8"), which separates the rear compartment seating area from the storage area. The specification of Stahl identifies Partition 8 as dividing the body of the vehicle into a crew carrying compartment and a storage compartment. See col. 2, ll. 48-50. Thus, the storage compartment of Stahl occupies the entire rear portion of the vehicle.

The Examiner suggests that the vehicle in Stahl can be provided with the storage area of Hawkins which is argued to be less than the width of the wheel. However, such a combination does not satisfy the claim limitation of a storage area which extends into the enclosure no further than the wheel well extends into the enclosure. The incorporation of the storage system of Hawkins in the vehicle of Stahl does not teach limiting the storage to a width not greater than the wheel well because the storage compartment of Stahl is defined by the location of Partition 8 as per the specification of Stahl. Thus, the combination of Stahl and Hawkins does not satisfy the claim limitation that the storage compartment extend into the enclosure no further than the wheel well.

In order to limit the storage compartment of Stahl so that it does not extend into the enclosure further than the wheel wells extend into the enclosure, it would be necessary to remove Partition 8, thereby greatly enlarging the passenger compartment and eliminating the large scale storage capacity of the vehicle in Stahl. This type of change would render the vehicle in Stahl unfit for its intended purpose and dramatically alter the character of the vehicle.

The Examiner has not asserted that any other secondary or tertiary references

meet the claim limitation regarding the extent to which the storage compartment extends into the enclosure. The Examiner has cited Hamel and other tertiary references only to show limitations such as hinges, struts, and drains. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness because he did not shown that the references teach or suggest every claim limitation. Appellants thus respectfully request that all rejections over Stahl be overturned.

J. All of the Examiner's Rejections Under 35 U.S.C. § 103(a) Should Be Overturned Because the Examiner Has Impermissibly Engaged in Hindsight Reconstruction of Appellants' Invention.

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- A) The claimed invention must be considered as a whole;
- B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- D) Reasonable expectation of success is the standard with which obviousness is determined." MPEP § 2141 (quoting *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986))

All of the Examiner's rejections show that the Examiner refused to consider the invention as a whole and instead merely pointed out, in an assortment of references, several features of Appellants' invention.

The Examiner failed to establish a *prima facie* case of obviousness and ignored the standards for evaluating patentability announced by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) and as cited in MPEP § 2141, which are to be applied in "each and every case." In *Graham*, the Supreme Court stated that patentability is determined by:

- A) Determining the scope and content of the prior art;
- B) Ascertaining the differences between the prior art and the claims in issue;
- C) Resolving the level of ordinary skill in the art; and
- D) Evaluating evidence of secondary considerations.

Instead of following the objective method of evaluating obviousness established by the Supreme Court and detailed in the MPEP, the Examiner made conclusory statements claiming that the Appellants' invention is obvious in light of the prior art. The Examiner clearly engaged in improper hindsight reconstruction of Appellants' invention. The Examiner's hindsight reconstruction is revealed in his combination of references in a manner which would render the references unfit for their intended purposes. The Examiner also did not offer any reasoning explaining a *prima facie* case of obviousness and did not discuss the *Graham* factors. In light of the Examiner's total failure to comply with the requirements for making obviousness determinations, Appellants respectfully request that the Board overturn all of the Examiner's rejections.

K. Claims 57, 74 And 87 Should Be Allowed With No Further Amendments Or Limitations.

The Action objected to claims 57, 74 and 87 as "being dependent upon a rejected base claim, but "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Because the rejections of the base claims are properly overturned in the face of the arguments set forth above, Appellants respectfully submit that these claims too are in condition for allowance as they currently stand, and request that the objection to these claims be withdrawn and the claims allowed.

L. Claims 94, 96-97, 126 and 127 Are Unchanged, Thus Remain Allowed

The Action indicated that claims 94, 96-97, 126 and 127 are allowed. As these claims have not been amended in this Appeal, they remain allowed.

M. Conclusion

Claims 49-56, 58-62, 64-73, 85-86, 88-89, 91, 92, 98, 99, 101, 105, 106, 108, 109, 111, and 113 are patentable over the prior art, and the Appellants respectfully request that all rejections be overturned.

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In the meantime, if the Examiner has any questions or comments, or believes that certain amendments of the claims would advance this case toward allowance, a telephone call to the undersigned Appellants' representative at (512) 542-8446 is earnestly solicited.

Respectfully submitted,



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Date: January 19, 2006

CLAIMS APPENDIX

1-48. (canceled)

49. (previously presented) A storage system for a vehicle having a driver compartment and a passenger compartment rearward of the driver compartment and within a single enclosure, wherein the enclosure is defined by a floor, a roof, two opposing side walls which each connect the roof to the floor, and exterior side panels, wherein the passenger compartment includes opposing rear wheel wells extending into the passenger compartment from the bottom edges of the side panels,

the storage system comprising at least one storage area adjacent to and separated from the passenger compartment, the storage area being defined by at least a portion of an exterior side panel, an inner panel, a top and bottom which connect the inner panel to the exterior side panel, and wherein the storage area extends into the passenger compartment no further than the wheel well extends into the passenger compartment,

wherein at least one section of the exterior side panel is hinged to provide access to the storage area therein.

50. (previously presented) The storage system of Claim 49, wherein at least one storage area extends over at least one rear wheel well.

51. (previously presented) The storage system of Claim 49, wherein at least one storage area extends forward and rearward from at least one wheel well.

52. (previously presented) The storage system of Claim 49, wherein at least one storage area is constructed to extend along a substantial portion of the side panel.

53. (previously presented) The storage system of Claim 49, wherein the storage area is enclosed and the enclosed storage area includes a plurality of cooperating latch members mounted on the storage area and the at least one hinged section of the at least

one side panel.

54. (previously presented) The storage system of Claim 49, further comprising at least one mechanism for retaining the at least one hinged section closed.

55. (previously presented) The storage system of Claim 49, wherein each side of the vehicle is provided with at least one storage area and at least one hinged section.

56. (previously presented) The storage system of Claim 49, additionally including at least one strut assembly operatively connected to retain the at least one hinged section of the side panel in an opened position.

57. (previously presented) The storage system of Claim 56, wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or insulation and heating.

58. (previously presented) The storage system of Claim 49, wherein at least one of the side panels includes more than one hinged section that is capable of being opened to expose the storage area.

59. (previously presented) The storage system of Claim 49, additionally including at least one drain/air relief valve assembly mounted in the at least one storage area.

60. (previously presented) The storage system of Claim 49, wherein the at least one storage area includes at least one of an adjustable shelf, a slideable shelf, a movable shelf, and a drawer.

61. (previously presented) A vehicle having a forward compartment for carrying a driver, and including at least one forward side door providing access to the forward compartment, and a rear compartment for passengers, merchandise or equipment wherein the rear compartment is disposed to the rear of the driver compartment, wherein the forward and rear compartments are contained in a single enclosure, and further wherein

the rear compartment is bounded by exterior, contoured side panels and a rear, including at least one rear door, and optionally at least one rear side door, and wherein each side panel has a lower perimeter that includes a curve to accommodate a rear wheel well adjacent each side panel;

the vehicle comprising at least one storage area disposed between a rear-most one of said side doors and the rear of the vehicle, and adjacent at least one exterior, contoured side panel and extending into the enclosure of the vehicle no further than the wheel well extends into the enclosure, and wherein the side panel adjacent the storage area includes a hinged section effective to provide an opening from the exterior of the vehicle into the storage area, and further wherein the separation width and cross sectional contour of the side panels of the enclosure is substantially the same as the separation width and cross-sectional contour of the forward compartment where it adjoins the side panels of the enclosure.

62. (previously presented) The vehicle of Claim 61, wherein the storage system is located intermediate the driver compartment and the rear door.

63. (canceled)

64. (previously presented) The vehicle of Claim 61, wherein the storage system is mounted in the side panel of the enclosure on the driver's side of the vehicle.

65. (previously presented) The vehicle of Claim 61, wherein there is a storage system mounted in the side panels of the enclosure on both sides of the vehicle.

66. (previously presented) The vehicle of Claim 61, additionally including at least two hinged sections on at least one side of the enclosure, the hinged sections enabling access to at least a portion of the interior of the storage area.

67. (previously presented) The vehicle of Claim 61, wherein a storage area is located

one of forward or rearward of the wheel well.

68. (previously presented) The vehicle of Claim 61, wherein a storage area is located over the wheel well.

69. (previously presented) The vehicle of Claim 68, wherein the hinged section is located entirely above the wheel well.

70. (previously presented) The vehicle of Claim 68, wherein the hinged section is located over the wheel well.

71. (previously presented) The vehicle of Claim 68, wherein the hinged section is located forward and rearward of the wheel well.

72. (previously presented) The vehicle of Claim 66, wherein at least one of the hinged sections is hinged horizontally.

73. (previously presented) The vehicle of Claim 61, additionally including at least one strut assembly operatively connected to retain the hinged section in an opened position.

74. (previously presented) The vehicle of Claim 73, wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or heating and insulation.

75-84. (canceled)

85. (previously presented) A vehicle comprising an enclosure containing at least two rows of seats for a driver and passengers, the enclosure comprising:

a floor area bounded on either side by side panels with exterior surfaces defining the width of the enclosure, two opposed rear wheel wells, one at each side of the floor panel,

at least one hinged section in the exterior surface of at least one of the side panels,

at least one storage area located adjacent the at least one hinged section, and extending into the enclosure to an inner wall of the storage area, wherein the hinged section is configured to provide access to the storage area when the hinged section is in the open position and wherein the width of the storage area is not greater than the width of the wheel well;

a latch for retaining the at least one hinged side panel section in the closed position; and

a strut for retaining the hinged section in the open position.

86. (previously presented) The vehicle of Claim 85, wherein the at least one hinged section is hinged one of horizontally and vertically.

87. (previously presented) The vehicle of Claim 85, wherein a temperature control for the strut is provided by at least one of insulating, heating, or heating and insulating.

88. (previously presented) The vehicle of Claim 85, additionally including at least one drain/air relief valve assembly mounted in the at least one storage area.

89. (previously presented) The vehicle of Claim 85, wherein the vehicle includes at least one hinged section in each of the side panels and at least one storage area located adjacent the hinged sections.

90. (canceled)

91. (previously presented) The vehicle of Claim 85, wherein the enclosure comprises a front row of seats and a rear row of seats.

92. (previously presented) The vehicle of Claim 91, wherein the enclosure comprises a cargo area behind the rear most row of seats.

93. (canceled)

94. (previously presented) A vehicle comprising a driver's compartment and a rear

compartment, the rear compartment including a storage system, the rear compartment comprising:

a floor area with opposing edges, a roof with opposing edges, and bounded on either side by side panels extending from the opposing edges of the floor panel to the opposing edges of the roof, and being outwardly bowed, defining the width of the rear compartment and at least one hinged section in the exterior surface of at least one of the side panels,

at least one storage area located intermediate the side panels, adjacent the at least one hinged section, and extending into a cargo area of the vehicle, wherein the hinged section is configured to provide access to the storage area when the hinged section is in the open position;-and

a strut for retaining the hinged section in the open position, wherein a temperature control for the strut is provided by at least one of insulating, heating, or heating and insulating.

95. (canceled)

96. (previously presented) The vehicle of Claim 94, wherein the rear compartment comprises a passenger compartment.

97. (previously presented) The vehicle of Claim 94, wherein the rear compartment comprises a cargo area.

98. (previously presented) The storage system of Claim 49 wherein one section of the side panel is hinged to open outwardly to the exterior of the vehicle.

99. (previously presented) The storage system of Claim 49 wherein more than one section of the side panel is hinged to open outwardly to the exterior of the vehicle.

100. (canceled)

101. (previously presented) The storage system of Claim 49 wherein the vehicle is a van.

102-104. (canceled)

105. (previously presented) The storage system of Claim 50 wherein the width of the storage area is approximately the same as the width of the wheel well.

106. (previously presented) The storage system of Claim 49 wherein a portion of the sidewall of the passenger compartment is the opposing side of the inner panel of the storage area.

107. (canceled)

108. (previously presented) The storage system of Claim 49 wherein the storage system is fabricated on an assembly line.

109. (previously presented) The vehicle of Claim 61 wherein the storage area is inaccessible from the enclosure.

110. (canceled)

111. (previously presented) The vehicle of Claim 61 wherein the vehicle is a van.

112. (canceled)

113. (previously presented) The vehicle of Claim 61 wherein the vehicle is fabricated on an assembly line.

114-125. (canceled)

126. (previously presented) A storage system for a vehicle having a cargo area and a pair of side panels disposed on either side of the cargo area, the storage system comprising at least one storage area located intermediate the side panels and extending into the cargo area of the vehicle, and comprising:

at least one opening effective to expose the interior of the storage area;

at least one section of at least one of the side panels being hinged, the hinged section effective to provide access to the storage area therein,
and wherein said storage system comprises at least one strut assembly operatively connected to retain the at least one hinged section of the side panel in an opened position and wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or heating and insulation.

127. (previously presented) A vehicle having a forward compartment for carrying a driver and an enclosure for passengers, merchandise or equipment wherein the enclosure is disposed to the rear of the driver compartment, and further wherein the enclosure is bounded by side panels and a rear wall, including at least one rear door, the vehicle comprising at least one storage area adjacent at least one side panel and extending into the enclosure of the vehicle, and wherein at least one side panel includes a hinged section effective to provide an opening from the exterior of the vehicle into the storage area and a mechanism for securing the at least one hinged section in the closed position, wherein said vehicle includes at least one strut assembly operatively connected to retain the hinged section in an opened position and wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or heating and insulation.



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This paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service on the date indicated above and is addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Re: U. S. Patent Application Serial No. 09/083,422 entitled "A STORAGE SYSTEM FOR VEHICLES" by Scott Clare et al.; Confirmation No. 3984
Attorney Dkt. No.: INN643/4-013/58000

Sir:

Enclosed for filing in the above-referenced patent application are the following:

1. Response to Notification of Non-Compliant Appeal Brief dated December 19, 2005 (in triplicate); and
2. A return postcard to acknowledge receipt of this document. Please date stamp and mail this postcard.

No fees are believed due at this time. If additional fees are due related to the enclosed document, the Commissioner is authorized to appropriately deduct or credit the requisite amount from VINSON & ELKINS L.L.P. Deposit Account No. 22-0365/INN643/4-013/58000.

Respectfully submitted,

Timothy S. Corder
Patent Agent
Reg. No. 38,414

9282:3058
Enclosure